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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,954

08/10/2006

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EXAMINER

LEE, NICHOLAS J

ART UNIT

PAPER NUMBER

2627

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,954	<b>Applicant(s)</b> HARAGUCHI ET AL.	
	<b>Examiner</b> NICHOLAS LEE	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/10/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 16 is drawn to a “program” *per se*, therefore, fail(s) to fall within a statutory category of invention.

A claim directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

See MPEP § 2106.01. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and

other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,971,024 B1 to Sako et al ("Sako") in view of US Patent Pub. 2002/0159360 A1 to Tosaki et al ("Tosaki").

As to claim 1, Sako discloses a recording medium comprising an uncompressed information recording area (Fig. 2, PA1) where uncompressed

information which is obtained by encoding reproduction information to be reproduced in an uncompressed state (col. 3, lines 35-48), a first control information area (Fig. 2, LI1) where uncompressed information control information for controlling the uncompressed information is recorded (Fig. 4, 5; col. 5, lines 35 - col. 6, lines 1-27), a compressed information record area (Fig. 2, PA2) where compressed information obtained by encoding another reproduction information including at least a content same as a part of the reproduction information (col. 3, lines 35-48), and a second control information area (Fig. 2, LI2) where compressed information control information for controlling the compressed information is recorded.

Sako further discloses wherein information from the first data area comprising the uncompressed data and the second data area comprising the compressed data are searched for showing a corresponding relationship between the compressed information and the uncompressed information (Fig. 4, 5; col. 5, lines 35 - col. 6, lines 1-27).

However, Sako fails to disclose a recording medium wherein the corresponding relationship information is found by referring to the compressed information control information recorded in the second information control area.

Tosaki discloses a first control data area wherein copyright or key information is recorded wherein the key information is used to decipher data to reconstruct the original data (¶ 0032-0033).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have combined Sako with the teachings of Tosaki to have an optical medium comprising control data areas comprising key information rather than a watermark as disclosed by Sako. The key information formed by embossment with a laser light recorded into a control data area. The two arts are directed towards copyright protection of recording mediums and the method of reproducing and recording information therein.

As to claim 2, the same rejection or discussion is used as in the rejection of claim 1. Sako discloses that in Fig. 19 wherein a first strong watermark is detected in the second data area of and if detected searching for a strong/ weak watermark of the first data area (col. 18, lines 42-48).

As to claim 3, the same rejections or discussions are used as in the rejections of claims 1 and 2.

As to claim 4, the same rejections or discussions are used as in the rejections of claims 1 and 2. Tosaki discloses a key information which is used to decipher and reconstruct information to be copied to another medium.

As to claim 5, the same rejections or discussions are used as in the rejections of claims 1 and 2. Fig. 15 discloses a diagram wherein if no cipher text is present the information can be free copied.

As to claim 6, the same rejections or discussions are used as in the rejections of claims 1 and 2.

As to claim 7, the same rejection or discussion is used as in the rejection of claim 1. Tosaki further discloses a recording means (Fig. 3, ¶ 0041-0047) which records the control information and main information in the recording medium. It would be obvious that the recording means of Tosaki could be used to record the uncompressed and compressed information disclosed by Sako.

As to claim 8, the same rejections or discussions are used as in the rejections of claims 2 and 7.

As to claim 9, the same rejections or discussions are used as in the rejections of claims 3 and 7.

As to claim 10, the same rejections or discussions are used as in the rejections of claims 4 and 7.

As to claim 11, the same rejections or discussions are used as in the rejections of claims 5 and 7.

As to claim 12, the same rejections or discussions are used as in the rejections of claims 6 and 7.

As to claim 13, the same rejection or discussion is used as in the rejection of claim 1. Tosaki further discloses an information reproducing apparatus comprising a selection means used for selecting any one of the a reproduction process of extracting the reproduction information out of the recording medium and reproducing thus extracted and a copy process of detecting reproduction information out of the recording medium and copying thus detected to another recording medium, a reproducing means, and a detection means (¶ 0041-0047).

It would be obvious that the reproducing means of Tosaki could be used to reproduce the uncompressed and compressed information disclosed by Sako.

As to claim 14, the same rejection or discussion is used as in the rejection of claim 7.

As to claim 15, the same rejection or discussion is used as in the rejection of claim 13.

As to claim 16, the same rejection or discussion is used as in the rejection of claim 7.

As to claim 17, the same rejection or discussion is used as in the rejection of claim 13.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS LEE whose telephone number is (571)270-7354. The examiner can normally be reached on Monday-Friday 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NICHOLAS LEE/  
Examiner, Art Unit 2627

/Thang V. Tran/  
Primary Examiner, Art Unit 2627